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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/826,570 | 04/16/2004 | Joerg-Peter Schmidt | GK-OEH-182/500814.20084 | 1765 |

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| EXAMINER |
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HECKENBERG JR, DONALD H

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| ART UNIT | PAPER NUMBER |
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1722

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,570

Applicant(s)

SCHMIDT ET AL.

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 11 and 15 is/are rejected.
- 7) ☒ Claim(s) 2-9 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1722

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10, 11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bawa et al. (U.S. Pat. No. 4,732,715; previously of record).

Bawa discloses a device for the manufacture of contact lenses. The device includes a mold half (22) that comprises a shaping beam outlet surface (see Figs. 1 & 2). The devices further includes lines (23) which in effect constitute a diaphragm or radiation-impermeable layer (see cl. 2, ll. 33-40). The radiation-impermeable diaphragm-lines (23) are enclosed and completely surrounded by the mold half (22), which is made radiation-transparent material (see Figs. 1-3 showing the mold half surrounding the lines, with the mold half allowing the radiation 30 to pass through at all other points where the lines are not present). As such, the shaping beam outlet surface of the mold half is spatially limited by the diaphragm- the diaphragm does not allow the radiation to pass through all points of the outlet surface.

Art Unit: 1722

3. Applicant's arguments filed 14 October 2005 have been fully considered but they are not persuasive.

Applicant argues that the diaphragm of the instant application does not need to be adapted to an existing surface contour. Applicant asserts that Bawa, in contrast, discloses a mask that does not limit the illuminating bundle of light but instead casts a shadow on the material to be hardened out. By this mask, Applicant further asserts, the hardening out of the material is influenced locally and not prevented from determining the form of the emerging contact lens. Thus, Applicant concludes that Bawa does not form a contact lens using a diaphragm as in the present invention.

Applicant's arguments are not commensurate with the scope of claims 1, 10, 11, and 15. The claims do not describe the adaptability features of the forming surface, and do not define the diaphragm as determining the form of the molded lens. Rather, these claims recite a diaphragm that is made of a radiation-impermeable layer, with the diaphragm spatially limiting the beam outlet surface.

Bawa's disclosed mold anticipates such a structure. As described above, the mask 22 comprises a beam outlet shaping surface, and the lines 23 constitute a diaphragm as these

Art Unit: 1722

structures are recited in the claims. To be more specific, radiation is passed through mask 22, with the diaphragm-lines 23 blocking the radiation at certain points. As a result, a shadow is formed on the molding material (see for example Figs. 2 and 3). Thus, the diaphragm-lines must necessarily be radiation-impermeable (in order to form a shadow), and the mask is acting as a shaping beam outlet surface. Further, the presence of a shadow indicates that the diaphragm is spatially limiting the beam outlet surface- it is not allowing the beam to fall on the areas indicated by the shadow. As such, Bawa discloses all of the structures recited in claims 1, 10, 11, and 15.

4. Claims 2-9 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See the reasons for indicating allowable subject matter in the previous Office Action.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

Art Unit: 1722

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1722

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Primary Examiner
A.U. 1722

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